IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Steve Grove et al.	Examiner: Cam Truong
Serial No.:	10/648,125	Group Art Unit: 2169
Filed:	August 25, 2003	Docket No.: 2043.102US1
Customer No.: 49845		Confirmation No.: 3210
Title:	METHOD AND SYSTEM TO GENERATE A LISTING IN A NETWORK-BASED COMMERCE SYSTEM	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants request review of the final rejection in the above-identified application in the Final Office Action mailed January 4, 2010. The application has been pending for over seven years. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

All claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyden as primary reference, in view of several secondary references (Dicker, Grefenstette, Maze, Ortega, Bozos, and Sick).

The Rejection Does Not Make Out A Prima Facie Case Of Obviousness

As to claim 1, The Office Action states at page 8:

> Boyden teaches a method of generating a listing in a network based commerce system (generating data in fields 218-220 in a network based commerce system, page 4, col. Right, lines 17-23; page 3, paragraph [0024], lines 4-10)....

The Office Action then goes on to discuss the limitations of claim 1 that Boyden is alleged to teach. Applicants do not agree that Boyden teaches the limitations that the Office Action alleges Boyden teaches, or that Boyden even teaches a method of generating a listing in a network based commerce system. But assuming that the above quotation is true, and that Boyden does teach the limitations of claim 1 that the Office Action alleges Boyden teaches (neither of which points Applicants concede), the obviousness rejection (taking Dicker as the secondary reference) should be withdrawn because (1) the combination of Boyden and Dicker does not teach each and every limitation of the claims. and (2) Boyden and Dicker cannot rightfully be combined under 35 USC 103(a).

The Combination Of Boyden And Dicker Does NOT Teach Each And Every Element Of Claim 1

The Office Action combines Boyden and Dicker beginning at the bottom of page 11. There the Office Action states:

> Boyden does not explicitly teach the claims limitation "receiving a category selection <u>from a seller</u>, verifying the category supports automated generation for proposed listings, receiving an indication from the seller selecting a selected listing from the plurality of similar listings." (Emphasis added)

The Office Action then goes on to state at page 12, lines 6-12:

> Dicker teaches the <u>user</u> selects a specific category such as 'non-fiction' from a drop down menu 202 to require category-specific recommendations. Designating a specific category causes items in all other categories to be filled out (paragraph 0169). The selected category is verified to support automated generation for recommendations lists as proposed listings (Fig. 5, paragraphs 0156, 0165-0167) Selecting similar items are from plurality of similar listings and displayed to a user (Figs. 11-12, paragraphs 004, 0061). (emphasis added)

<u>First</u>, the Examiner's citations --Fig. 5 and paragraphs 0156, 0165-0167--have NOTHING to do with verifying that a category supports automated generation for proposed listings, as the Examiner asserts, or, for that matter, **verifying anything at all**. All Dicker discusses are recommending items for purchase based on the contents of the buyer's shopping cart. This is seen in Dicker's abstract[1]. It's also seen in [0167] which states, "In step 192 one or more **items** are optionally <u>selected from the recent shopping cart contents</u>...." (emphasis added). Thus <u>individual items placed in the shopping cart</u> are what Dicker teaches, **not category selections** <u>as required by the claim limitation</u>, and <u>certainly not for the purpose of verifying anything whatsoever, much less that the category supports automated generation for proposed listings</u>. The Office Action also cited [0167] in the above quotation but, as the quotation of the foregoing sentence shows, [0167] does **not** state what the Office Action asserts it states.

<u>Second</u>, as seen also in Fig. 5 of Dicker, which the Office Action cites in the above quotation, (again, Applicants believe this citation is incorrect), Dicker <u>weights</u> the <u>items that are the</u> **contents** <u>of the shopping cart</u> (<u>not a</u> **category selection** as the claim requires), then rates the **contents** from high to low, and recommends the top M **items** (again, not category selections) into one or more Web pages (see page 13 of Dicker, col. Right, lines 1- 6). **THIS HAS NOTHING TO DO WITH VERIFYING THAT THE CATEGORY SELECTION FROM THE SELLER SUPPORTS AUTOMATED GENERATION FOR PROPOSED LISTINGS** as the claim requires, or verifying anything at all. If the Examiner continues holding the position that Dicker teaches verifying, the Examiner is requested to identify precisely where in Dicker this verification

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1 "An improved user interface and method are provided for presenting recommendations to a user **when the user adds an item to a shopping cart**.... (e.g., <u>recommendations based on</u> **shopping cart contents**, recommendations

is discussed. In this regard, an electronic search of Dicker yields no instance of the use of the word "verify," or

any word in the form of "verify*****." Nor has the undersigned found a discussion of a verification function

in Dicker. The Office Action appears to have confused **displaying recommendations based on the contents**

of the buyer's shopping cart with the claim limitation **"receiving a category selection from a seller and**

verifying that the category supports automated generation of proposed listings."

For the above reasons, Dicker does not provide the limitation that the Office Action acknowledges is

missing from Boyden, namely "verifying the category (received from the Seller) supports automated generation

for proposed listings." Therefore the combination of Boyden and Dicker cannot teach every claim limitation of

claim 1.

Furthermore, the Office Action t page 12, line 13 to page 13, line 6, merely states a conclusion of

obviousness:

> It would have been obvious to a person of an ordinary skill in the art at the time the invention
> was made to apply Dicker's teaching of receiving a category selection from a user and
> verifying the category supports automated generation for recommendation lists and selecting
> similar Items and displaying similar items to Boyden's system in order to allow a user to
> select a particular similar item listing so that the service can retrieve another similar item lists
> based *[upon]* the selected similar list and further to predict the interest of user based on the
> user's indication so that the system provides a recommendation of similar items based on the
> interests of users.

The foregoing quotation is a long statement, only a small part of which actually appears as a limitation

of claim 1. Claim 1 requires

> "receiving a category selection from a seller" and "verifying the category supports automated
> generation for proposed listings."

But the Examiner states that Dicker teaches:

> "verifying the category supports automated generation <u>for recommendation lists</u> and selecting
> similar items and displaying similar items...."

The claim simply does not say what the Examiner asserts it says. The reader is requested to read the

above two quotes next above, the first being the claim limitation and the second being the Examiner's

statement. Nowhere in the claim is there a requirement for a <u>recommendation list</u> as the Examiner states. So

even accepting the Examiner's statement, the combination of Boyden and Dicker does not teach each and every

limitation of claim 1.

The Examiner has simply missed the point of the instant application. Therefore the Examiner has not

provided the "articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness" required by *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). This reasoning cannot be

based on purchase history, etc.)...."

provided because the Examiner appears to think that Applicants' invention has to do with providing recommendations to buyers. It doesn't. It's a way for a seller to creating a listing. In fact, the Examiner's statement of obviousness amounts to a *per se* rule of unpatentability which was looked upon with disfavor in *Ex Parte William J. Gibson, Jr.,* appeal 2008-002819, decided September 30, 2009. There, at pages 7-8, the Board stated that "reliance on *per se* rules of obviousness is legally incorrect **and must cease**." Therefore the obviousness rejection should be withdrawn.

Boyden And Dicker Cannot Rightfully Be Combined Under 35 USC 103(a).

Finally, the two references can't rightfully be combined under 35 USC 103(a). This is because Dicker **teaches away** from Applicants' claimed invention. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the Applicants took. In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); United States v. Adams, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); In re Caldwell, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Assuming that the Examiner is correct (which Applicants do not concede), Boyden teaches creating a listing in a commerce system. As explained above, and as seen at least in Dicker's abstract, Dicker teaches a user interface and method are provided for **presenting recommendations to a user when the user adds an item to a shopping cart**. The two claim limitations Dicker is alleged to suggest are: first, "receiving a category selection from a seller," and, second, "verifying the category supports automated generation for proposed listings." Dicker teaches away from the claim limitations because a reference that teaches generating recommendations for purchase would not suggest steps in the process of generating listings for those items, namely "receiving a category selection and then verifying that the category supports automated generation of proposed listings." The reason Dicker would not suggest this is that Dicker teaches recommending items based on what a buyer places in the buyer's shopping cart. The instant application, on the other hand, claims creating a listing for those items which are being placed in the shopping cart. This is a step that occurs **before** the recommending of items that Dicker teaches. So Dicker, which operates **after** the teaching of the instant application occurs, would teach away from the earlier process of the instant application.

For the above reasons Applicants request that the obviousness rejection of independent claim 1 be withdrawn. further, the Office Action makes the same rejection as to independent claim 13 (at page 16, lines 20-21, and at page 17, lines 1-12) and as to independent claim 23 (at page 21, lines 10-21). These rejections must fail for the same reason as explained with respect to claim 1. Therefore claims 1, 13 and 23, which are the only independent claims in the application, are allowable, and their dependent claims are allowable for the

same reasons. Therefore Applicants request the withdrawal of the obviousness rejection from all claims and that they be passed to issue.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (530) 889-2402 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

Respectfully submitted,

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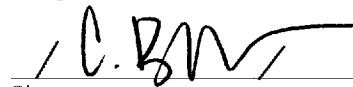(530) 889-2402

Date 04 March 2010   By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of March, 2010

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